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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,945	12/19/2001	William D. Denison	215001	8390

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CHICAGO, IL 60601-6780

EXAMINER

ZIMMERMAN, BRIAN A

ART UNIT	PAPER NUMBER
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2635

14

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/024,945

**Applicant(s)**

DENISON ET AL.

**Examiner**

Brian A Zimmerman

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 40-67 is/are pending in the application.  
4a) Of the above claim(s) 63 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 40-62 and 64 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

**EXAMINER'S RESPONSE**

**Status of Application**

In response to the applicant's amendment received on 1/22/04. The examiner has considered the new presentation of claims and applicant arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 40-62,64 are unpatentable for the reasons set forth in this office action:

***Election/Restrictions***

1. Newly submitted claim 63 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 63 is directed to a low battery detection circuit, which has not been previously considered. The claimed invention being considered is communication and programming of an electronic lock system.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 63 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Double Patenting***

2. Claims 43-62 are is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10 and 13 of U.S. Patent No. 5617082.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims are narrower than the pending claims and include all the currently claimed limitations. Therefore, the pending claims would have been obvious in view of the patented claims.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 41,43-49,51,53,59,61,64 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claims 41 and 43, support could not be found, in the original specification for entering the permanent access code **immediately following** the pressing of the program key. Regarding claim 41, support could not be found, in the original specification for the program key being wired to one

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of multiple interrupt pins of the microprocessor. Regarding claim 48, this claim depends from claim 41 and includes all the limitations but do not correct the problems pointed out above and are therefore rejected for the same reason as claim 41. Regarding claims 44-47, these claims depend from claim 43 and include all the limitations but do not correct the problem with pointed out above and are therefore rejected for the same reason as claim 43. Regarding claims 48,49,51,53,59,61, and 64, these are new claims which support in specification has not been pointed to by the applicant and the examiner could not find support for these claim limitations in the specification as originally filed.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this

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application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 40-45,48-55,57-61,64 rejected under 35 U.S.C. 102(e) as being clearly anticipated by Henderson (5602536).

Henderson shows an access control device having a microprocessor based control circuit 28 and non-volatile memory 44. Henderson also shows the control device to include a communication port (see figure 24) for writing data to the memory of the access device. A key can send a read signal through the port to trigger the access device to send the access code stored in memory and receive the access code from the access device through the port. The key can also send an access code through the port to program the access device. The key includes a keypad and a clear key, see col. 15 line 55+. The device of Henderson also includes a low battery detector see col. 31 lines 55+. See col. 4 lines 1-5, col. 5 lines 60+, col. 7 lines 5+, col. 13 lines 25+, col. 14 lines 55+. Henderson also provides a sleep mode for the access device such that upon receipt of a signal via the communication port, the access device wakes up, see col. 24 line 5+.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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5. Claims 46,47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson as applied to claim 43 above, and further in view of McNair.

In an analogous art, McNair teaches disabling for a period of time if the device receives an number of consecutive invalid inputs. This improves security in that the ability to break into the codes is reduced. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the McNair method of disabling in the Henderson access system in order to improve security.

6. Claims 56 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson as applied to claim 54 above, and further in view of Imran (5090222).

In an analogous art, Imran shows a lock solenoid with the power levels claimed for opening and maintaining the lock in an open position for reduced power consumption levels. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used the lock powering method of Imran in order to reduce power consumption in the Henderson access control system.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian A Zimmerman whose telephone number is 703-305-4796. The examiner can normally be reached on Off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Horabik can be reached on 703-305-4704. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brian A. Zimmerman  
Primary Examiner  
Art Unit 2635

BAZ